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BEST AVAILABLE COPY**REMARKS**

Favorable reconsideration of this application in light of the above amendments and the following remarks is respectfully requested. Claims 1-5 and 7-11 are pending in this application. No claims are amended or canceled herein. No claims have been allowed.

Claim Rejections – 35 U.S.C. § 103(a)

Claims 1, 4-5, 7 and 10-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kravitz (U.S. Patent No. 6,397,385) in view of Sten et al. (U.S. Patent No. 6,668,374; hereinafter “Sten”).

Kravitz teaches in general the limitations of applicant’s invention as claimed within claim 1 (i.e., independent method claim) and claim 7 (i.e., independent system claim) as originally filed. In particular, Kravitz (abstract) teaches those limitations with respect to a software upgrade of a telecommunications system that is otherwise continuously operating. Applicant has previously amended applicant’s claim 1 and applicant’s claim 7 to incorporate the limitation that applicant’s continuously operating computer system upgrade invention is claimed with respect to a firmware upgrade or a hardware upgrade of a continuously operating computer system, rather than a software upgrade of a continuously operating computer system as is taught by Kravitz.

The Examiner acknowledges that “Kravitz does not explicitly teach a firmware upgrade or a hardware upgrade” in accord with applicant’s invention as claimed within claim 1 and claim 7. Rather the Examiner asserts that Sten at col. 2, lines 22-25 teaches a firmware upgrade to a computer system in accord with applicant’s claimed invention. The Examiner further predicates suggestion or motivation for modification or combination of Kravitz with Sten such as “to minimize the amount of time required for a firmware upgrade,” as is apparently taught within Sten at col. 2, lines 26-27.

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In response, applicant asserts that Kravitz may not properly be combined with Sten in the fashion as suggested by the Examiner since there exists no suggestion or motivation for such modification or combination of Kravitz with Sten. More particularly, applicant asserts that the Examiner's predicate for suggestion or motivation for modification or combination of Kravitz with Sten, while representative of and derived from Sten, is apparently counterintuitive and not necessarily applicable with respect to Kravitz.

Within the context of the instant application, Kravitz is cited as a base reference otherwise teaching all of the limitations of applicant's claimed invention, but with respect to claim 1 and claim 7 absent a teaching of a firmware upgrade or a hardware upgrade of a continuously operating computer system. Kravitz at col. 2, lines 31-35 teaches that an object of Kravitz' invention is to provide an "upgrade of the software running on a continuously operating [computer] system . . . without interrupting the operation of the [continuously operating computer] system." In contrast, as cited by the Examiner, Sten teaches a time efficient firmware upgrade for a computer system.

A person skilled in the art would presumably clearly recognize that each of Kravitz and Sten is directed towards different objects with respect to upgrading a computer system. Thus, each of Kravitz and Sten at least implicitly provides a different suggestion or motivation for upgrading a computer system. Kravitz is motivated to upgrade a computer system while continuously operating the computer system. On the other hand, Sten is motivated to time efficiently upgrade a computer system. A person skilled in the art would likely readily recognize that an upgrade to a computer system while continuously operating the computer system is not necessarily a time efficient upgrade to the computer system. Rather, it is entirely plausible that an upgrade to a continuously operating computer system may be a particularly time inefficient upgrade since it presumably must be synchronized with other operating characteristics of the continuously operating computer system. In comparison, an upgrade to a computer system that is not continuously operating is more likely to be a time efficient upgrade since there is no

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apparent requirement for consideration of other operating characteristics of the continuously operating computer system.

In light of the foregoing analysis, applicant asserts that a person skilled in the art would not find a suggestion or motivation for modification or combination of Kravitz with Sten for time efficiency reasons as predicated by the Examiner and as cited within Sten, since those time efficiency reasons are likely inapplicable to Kravitz. Continuously operating computer system upgrades in accord with Kravitz are simply unlikely to be time efficient computer system upgrades as taught within Sten as being desirable.

Since there is no suggestion or motivation to modify or combine Kravitz with Sten for reasons as predicated by the Examiner, applicant asserts that claims 1, 4-5, 7 and 10-11 may not properly be rejected under 35 U.S.C. § 103(a) as being unpatentable over Kravitz in view of Sten.

In light of the foregoing response, applicant respectfully requests that the Examiner's rejections of claims 1, 4-5, 7 and 10-11 under 35 U.S.C. § 103(a) as being unpatentable over Kravitz in view of Sten be withdrawn.

Claims 2 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kravitz in view of Gross et al. (U.S. Patent No. 5,964,874; hereinafter "Gross").

Kravitz teachings are discussed in further detail above. In addition, the Examiner acknowledges that Kravitz teaches Kravitz' continuously operating computer system upgrade within the context of a telecommunications computer system, but not within the context of a computer system operated within a fabrication facility selected from the group consisting of chemical fabrication facilities, mechanical fabrication facilities and electrical fabrication facilities as claimed within claim 2 and claim 8. Nonetheless, the Examiner cites Gross at col. 1,

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lines 39-46 as teaching an upgrade of a computer system operated within a fabrication facility selected from the group consisting of chemical fabrication facilities, mechanical fabrication facilities and electrical fabrication facilities. The Examiner further predicates suggestion or motivation for modification or combination of Kravitz with Gross upon an interest in "reduc[ing] computer] system down time," as apparently taught by Gross at col. 2, lines 50-60.

In response, applicant appreciates that each of Kravitz and Gross may be understood as teaching a computer system update that may be undertaken such as to provide reduced computer system down time. However, applicant nonetheless asserts that Gross may not properly be combined with Kravitz to reject any of applicant's claims to applicant's invention since: (1) Gross teaches away from applicant's claimed invention and thus Gross may not be employed for rejecting any of applicant's claims to applicant's invention (MPEP 2141.02); and (2) Kravitz and Gross have conflicting teachings that are not reconciled, thus providing absence of suggestion or motivation for modification or combination of Kravitz and Gross (MPEP 2143.01).

In further detail with respect to Gross teaching away from applicant's claimed invention, applicant notes that applicant's invention is directed towards a method for upgrading a computer system while continuously operating the computer system. In comparison, Gross at the paragraph bridging cols. 1-2 does in fact teach a need for upgrading a computer system. However, Gross at abstract teaches that Gross' inventive upgrade to a computer system employs "booting the [computer] system to a maintenance mode." A person skilled in the art would certainly clearly understand that "booting the [computer] system" is a physical operation that requires turning the computer system off and restarting the computer system. Such an operation is clearly opposite to continuous operation of the computer system. Thus, Gross clearly teaches away from applicant's claimed invention with respect to continuous operation of a computer system when upgrading the computer system.

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Since Gross teaches away from applicant's claimed invention, Gross may not properly be employed in conjunction with other references for purposes of rejecting any of applicant's claims to applicant's invention. Clearly a person skilled in the art once recognizing that Gross teaches a discontinuous operation (i.e., off/on cycling) of a computer system when upgrading the computer system would make no further inquiry into other of Gross' teachings. Whether or not a computer system is operating when upgrading the computer system is a primary factor in both applicant's invention and Gross' invention. A person skilled in that art would first seek analogy with applicant's invention within the context of a continuous operation of a computer system when upgrading the computer system. Since Gross does not teach this primary feature of applicant's claimed invention, a person skilled in the art would certainly have no motivation to further evaluate Gross to ascertain lesser details such as a type of a fabrication facility within which Gross' computer system upgrade invention may be operated.

"A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would teach away from the claimed invention." *W.L. Gore & Associates, Inc. v. Garlock, Inc.* (MPEP 2141.02 (citation omitted)).

In further detail with respect to lack of suggestion or motivation for modification or combination of Kravitz with Gross, applicant also again notes that Kravitz teaches an upgrade of a computer system while continuously operating the computer system. In contrast as noted above, Gross teaches an upgrade of a computer system incident to rebooting the computer system to a maintenance mode. Thus, the teachings of the prior art Kravitz and Gross clearly conflict with respect to a primary issue of whether or not a computer system is continuously operating when the computer system is being upgraded.

"Where the teachings of the prior art conflict, the Examiner must weigh the suggestive power of each reference." MPEP 2143.01. Further, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior

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art suggests the desirability of the combination." MPEP 2143.01 (citing *In re Mills* (citation omitted)).

Clearly the Examiner has not even acknowledged that Kravitz and Gross conflict in their teachings with respect to the critical feature of whether or not a computer system is operating when upgrading the computer system. Given the absence of acknowledgement of such a conflict, clearly there is no weighing of suggestive power of each of the conflicting references. Given absence of weighing of suggestive power of each of the conflicting references the Examiner may not apparently properly assert suggestion or motivation for modification or combination of references.

In light of the foregoing responses, applicant respectfully requests that the Examiner's rejections of claim 2 and claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Kravitz in view of Gross be withdrawn.

Claims 3 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kravitz in view of Rohrer et al. (U.S. Patent No. 5,313,398; hereinafter "Rohrer").

Kravitz' teachings are discussed above. The Examiner acknowledges that Kravitz does not teach Kravitz' invention within the context of a computer system operated within a microelectronic fabrication facility. Nonetheless, the Examiner cites Rohrer at col. 5, lines 39-47 and col. 6, lines 21-34 as teaching a computer system operating within a microelectronic fabrication facility. The Examiner predicates suggestion or motivation for modification or combination of Kravitz with Rohrer such as to "simulate the design and manufacture of a microelectronic circuit in a computer system" as is apparently taught within Rohrer at col. 1, lines 5-10.

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While applicant acknowledges that Rohrer does in fact apparently teach simulation of design and manufacture of a microelectronic circuit within a computer system, applicant nonetheless respectfully asserts that that teaching by itself does not provide sufficient predicate for suggestion or motivation for modification or combination of Kravitz with Rohrer.

In particular, applicant first notes that Kravitz computer system that is upgraded while it is continuously operating is a telecommunications computer. Telecommunications computer systems apparently require continuous operation such as to provide continuous telecommunications customer access and service. In contrast, Rohrer's microelectronic circuit simulation computer system is quite unlikely to require continuous operation in a fashion that requires continuous customer access. Applicant is intuitively simply not aware that simulation of microelectronic circuit design and manufacture is of necessity undertaken within a computer system that of necessity is required to operate continuously. Rather, applicant intuitively asserts that upgrades to a microelectronic circuit simulation computer are likely to be readily undertaken during non-use hours.

Since a telecommunications computer system apparently requires continuous operation while a microelectronic simulation computer system apparently intuitively clearly does not require continuous operation, applicant asserts that there is no suggestion or motivation for modification or combination of Kravitz with Rohrer.

Since there is no suggestion or motivation for modification or combination of Kravitz with Rohrer, applicant asserts that none of applicant's claims to applicant's invention may properly be rejected under 35 U.S.C. § 103(a) as being unpatentable over Kravitz in view of Rohrer.

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In light of the foregoing response, applicant respectfully requests that the Examiner's rejection of applicant's claims 3 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Kravitz in view of Rohrer be withdrawn.

Other Considerations

Applicant again acknowledges the additional prior art of record cited by the Examiner on PTO Form 892 but not employed in rejecting applicant's claims to applicant's invention. No fee is due as a result of this response.

SUMMARY

Applicant's invention as disclosed and claimed within claims 1 and 7 is directed towards a method and system for upgrading a computer system with respect to firmware and hardware components. Applicant's invention as disclosed and claimed within claims 2-3 and 8-9 is directed towards a method and system for upgrading the computer system as employed within any of several enumerated fabrication facilities. The applied prior art does not make obvious applicant's invention as claimed within claims 1-3 and 7-9 since there is no suggestion or motivation to modify or combine the applied prior art.

CONCLUSION

On the basis of the above remarks, favorable reconsideration of this application, and its early allowance, are respectfully requested. Any inquiries relating to this or previous communications pertaining to this application may be directed towards the undersigned attorney at 248-540-4040, at the Examiner's convenience.

Respectfully submitted,

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